

## **Remarks/Arguments**

### **A. Request for Reconsideration**

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action, but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the amendments to the claims and the following remarks.

### **B. Claim Status and Comments**

Claims 1-8 are pending. Claim 1 been amended merely for grammatical purposes and to ensure proper antecedent basis. No new matter has been added.

### **C. Claim Rejections – 35 U.S.C. § 103**

Claims 1-7 had been rejected under 35 U.S.C. § 103(a) as being unpatentable over Singer (DE 100 43 840) in view of Kniepkamp, *et al.* (U.S. Patent No. 2,999,707) (hereinafter Kniepkamp), Leturcq (U.S. Patent No. 6,244,600) and Fessenden (U.S. Patent No. 4,229,950).

The Examiner acknowledged that Singer does not disclose a recess on the guidance federation (13) and an elastic holding element inserted in the recess such that the elastic holding element bears against the holding bore of the inner ring (7) under preload and turned to Kniepkamp. The Examiner stated that Kniepkamp teaches a plug (1) held against an inner bore of a casing (5) and that the plug includes a recess with an elastic holding element (12) inserted in the recess such that the elastic holding element bears against the holding bore of the casing under pre-load. However, the Examiner

acknowledged that Kniepkamp does not teach a recess as taught by the presently claimed invention and then turned to Leturcq stating that Leturcq teaches the recess of the presently claimed invention except for a first wall being shorter than a third wall, but noted that Fessenden teaches a first wall that is shorter than a third wall and that it would have been obvious to combine the four references.

Applicants respectfully disagree with the Examiner. It would not have been obvious to one of ordinary skill in the art to combine the references of Singer, with Kniepkamp, Leturcq and Fessenden. One of ordinary skill in the art would not have thought to combine the four references noted by the Examiner. The Examiner's combination of the references is hindsight and was done by piecemeal. Thus, since one of ordinary skill in the art would not have thought to combine the references cited by the Examiner, the presently claimed invention is patentable over the prior art references independently or in combination.

Applicants respectfully disagree with the Examiner that one of ordinary skill in the art would not think to incorporate the "twin tapered surface" of Kniepkamp into Singer since the design of Kniepkamp would not only require modifications of the guide federation (13), but also require modifications to the inner ring of Singer because the "twin taper surface" of Kniepkamp requires an opposing "twin taper surface" in the casing (5) as well to position the o-ring (12). One of ordinary skill in the art would not view Singer and find it obvious to add not one, but two "twin taper surfaces" to the design. Further, even adding the "twin taper surfaces" of Kniepkamp to Singer, one of ordinary skill in the art would not then think to then modify the "twin taper surface" incorporated into the guide federation and replace it with the recess of Leturcq. By then

modifying the “twin taper surface” of Singer/Kniepkamp to include the recess of Leturcq, would essentially eliminate the need for the “twin taper surface” on the guide federation. Moreover, one of ordinary skill in the art would not then think to modify the recess of Kniepkamp/Leturcq even further by shortening one of the walls by incorporating the shorter wall of the recess of Fessenden. The Examiner’s attempt to recreate the presently claimed invention by piecemeal is not what would have been envisioned by one of ordinary skill in the art at the time of the invention. The Examiner’s combination of references is mere hindsight and would not have been obvious to one of ordinary skill in the art. One of ordinary skill in the art would not have thought to combine such references and continually modify each reference further as the Examiner has attempted to do in this Office Action.

Thus, the presently claimed invention is distinguishable from and patentable over Singer in view of Kniepkamp, Leturcq and Fessenden and, therefore, Applicants respectfully request removal of this rejection.

Claims 2-8 are dependent upon claim 1, which as discussed above, is patentable over Singer in view of Kniepkamp, Leturcq and Fessenden. Since claim 1 is patentable over Singer in view of Kniepkamp, Leturcq and Fessenden, claims 2-8 are also patentable over Singer in view of Kniepkamp, Leturcq and Fessenden.

D. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and such action is respectfully requested.

Should any extensions of time or fees be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account Number 02-2275.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:   
Klaus P. Stoffel, Reg. No. 34,668  
Attorney for Applicant(s)  
475 Park Avenue South, 15<sup>th</sup> Floor  
New York, New York 10016  
Tel. 212-661-8000 Fax (212) 661-8002

KPS/JRW/jrp